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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,412

03/31/2006

Akira Sakurai

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EXAMINER

EDWARDS, NEWTON O

ART UNIT

PAPER NUMBER

1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,412	Applicant(s) SAKURAI ET AL.	
	Examiner N. EDWARDS	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/06,10/22/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1794

1. Applicant's election without traverse of group I claims 1-4 in the reply filed on 7/25/08 is acknowledged. The restriction is deemed proper for reasons of record and hereby made **Final**.

2. Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim (see claim 3). See MPEP § 608.01(n). Accordingly, the claim 4 not been further treated on the merits.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 overall is vague and indefinite as to the meaning of the claims. What is the claim trying to define?

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1, 2, and 3 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamane (US 6,312, 804).

For the record, the invention defined in a product by process claim is a **Product**, not a process. In re Bridgeford, 357 F.2d 679. It is the patentability of the product claimed and **NOT** of the recited process steps which must be established. In re Brown, 459 F.2d 531. In re Wertheim, 541, F. 2d 257. Thus, the product defined by claim 1 is a PVC fiber having an arithmetic mean roughness Ra and a maximum height RY as recited by claim 1.

Reading claim 1 in light of the specification reveals, the PVC fiber composition which yields the RA and RY of claim 1 is a PVC composition of claims 3 and 4 which is hereby incorporated by reference. See paragraphs 43, 50, 51, 52 of the spec.

Yamane teaches a PVC fiber or vinyl chloride fiber for use as hair or wig comprising a PVC fiber resin composition with full luster (gloss) having 100 part by weight PVC resin (vinyl chloride resin), 0.2 to 5 part by weight of more the one lubricant such as higher fatty acids lubricant, and polyethylene lubricant, 1.2-5 part by weight thermal stabilizer such as hydrotalcite or zeolite. See claim 1, claim 2, claim 3, and Col.8lines 1-15, for example.

Thus, the Primary Examiner has a reason to believe that that Yamane's PVC fiber inherent discloses the same calculated roughness RA, Ry, and gloss(claim 2) as claimed due to the same structural identity (composition, thermal stabilizer particles, lubricants) as claimed.

Art Unit: 1794

In the Alternative, regarding the issue of ranges of the components in the PVC fiber composition, in view of the overlapping ranges of the PVC fiber components, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary and control the ranges amounts, since it has been held that where the general condition of the claim(s) are disclosed in the prior art discovering the optimum or workable ranges involve only routine skill in the art. In re Aller, 105 USPQ 233.

No claims are allowed.

The cited patent disclose the state of the prior art.

Any inquiry concerning this communication should be directed to Primary Examiner Edwards at telephone number (571)272-1521.

/N Edwards/
Primary Examiner
Art Unit 1794